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EXAMINER

SALOMON, PHENUEL S

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/715,205	Applicant(s) GREEN ET AL.	
	Examiner PHENUEL S. SALOMON	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/17/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7,8,14,16,20,21,38-43 and 55-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7,8,14,16,20,21,38-43 and 55-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the Request for Continued examination filed on July 17, 2008. Claims 1,7,8,14,16,20,21,38-43 are amended; claims 2-6, 9-13, 15, 17-19, 22-37, and 44-54 are canceled; claims 55-81 are newly added and claims 1,7,8,14,16,20,21,38-43 and 55-81 are pending.

2. The rejections of claims 1, 3, 14, 16 and 40-43 under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Begole et al. (US 2004/0039630 A1) and in further view of Lee et al.(US2003/0233265 A1 have been withdrawn pursuant to applicant amendments and claims cancellation.

3. The rejections of claims 5-8 and 18-21 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Begole et al. (US 2004/0039630 A1) in view of Lee et al.(US2003/0233265 A1) and in further view of Widger (US 2005/0117733) have been withdrawn pursuant to applicant amendments and claims cancellation.

4. The rejections of claims 29-36 and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Lee et al. (US 2003/0233265 A1) have been withdrawn pursuant to applicant amendments and claims cancellation.

5. The rejections of claims 46-49 and 52 under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Begole et al. (US 2004/0039630 A1) have been withdrawn pursuant to claims cancellation.

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6. The rejections of claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Begole et al. (US 2004/0039630 A1) and in further view of Lee et al. (US2003/0233265 A1) have been withdrawn pursuant to claims cancellation.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 7-8, 55-60, and 67-75 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Claims 1, 7-8, 55-60, and 67-75 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are drawn to a computer readable medium, which the applicant has defined in the specification (page 5, lines 1-2 and p. 6, lines 4-5) to encompass “*propagated signal capable of providing...*” Thus, a propagated signal does not fall within any of the four categories of statutory subject matter. The examiner recommends **A computer readable storage medium**.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 14, 16, 20, 42, 55-57, 60-64, 67, and 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Begole et al. (US 2004/0039630 A1) and in further view of Imamura et al. (US 2002/0091774 A1).

Claims 1 and 14: Doss discloses a computer-readable medium and a method having embodied thereon a computer program, the computer program including instructions that, when executed, cause a computer to:

display, to a user of an instant messaging system, a graphical user interface that enables the user to access an instant messaging service, the graphical user interface comprising a window that includes a contacts list listing identifiers corresponding to multiple co-users of the instant messaging service, the contacts list being configured to make online presence information for the co-users perceivable to the user and to enable the user to initiate communication sessions with the co-users (p.1, para [0007] and [0008]); but does not explicitly disclose;

determine a number of unread e-mail messages that an exchanged between the user and a first one of the co-users;

conditioned on the number of unread e-mail messages being greater than zero, display, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user, a first graphical element that indicates that one or more unread e-mail messages have a first indication that reflects that an been exchanged between the user and the first co-user;

enable the user to select the first graphical element;

receive a selection of the first graphical element by the user; and

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in response to the selection of the first graphical element by the user, display to the user the number of unread e-mail messages exchanged between the user and the first co-user.

However, Begole discloses

determine that an email message has been exchanged between the user and a first one of the co-users (*comprising a list of contacts and associated awareness information, according to an embodiment of the present invention. This awareness information can be used to gauge the corresponding user's email receptiveness*) (p. 14, para. [0180]);

display, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user (*an indication of email receptiveness is displayed within a graphical user interface of a computer system associated with the first email user, or sender*) p. 15, para [0194]);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the email exchange notification in Doss. One would have been motivated to do so in order to facilitate data sharing as required while the user is being notified of such data transferred.

However, Imamura discloses

determine a number of unread e-mail messages (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]);

conditioned on the number of unread e-mail messages being greater than zero and a first graphical element that indicates that one or more unread e-mail messages (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]) [if there are no unread messages, there won't be anything to display].

enable the user to select the first graphical element (*window 600 includes the names 605 of the registered users, where each name 605 may also serve as a user-selectable icon*) (p. 5, para. [0053]);

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receive a selection of the first graphical element by the user (*window 600 includes the names 605 of the registered users, where each name 605 may also serve as a user-selectable icon*) [the icon is adjacent to each and is also selectable] (p. 5, para. [0053]); and

in response to the selection of the first graphical element by the user, display to the user the number of unread e-mail messages exchanged between the user and the first co-user (p. 5, para. [0053]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the unread icon in Doss. One would have been motivated to do so in order to alert users about unread email.

Claim 16: Doss Begole and Imamura disclose the method of claim 14 above, Doss further discloses receiving a selection of the first graphical element comprises receiving an indication that the user has moved a graphical pointer further over the graphical element corresponding to the first co-user in the contacts list (p. 2, para. [0018] lines 9-12).

Claim 20: Doss Begole and Imamura disclose the method of claim 14 above, Imamura further discloses comprising displaying the one or more unread email in response to a second selection of the graphical element by the user (p. 2, para. [0025]). One would have been motivated to add that feature in order to quickly access and review one's email content without interruption.

Claim 42: Doss Begole and Imamura disclose the method of claim 14 above Begole further discloses comprising:

determining that a second one of the co-users has left a voicemail message for the user (*similar graphics are also readily applicable to indicate receptiveness to other communication media as well*) (fig. 13a, item 1340 and p.15, para [0184]); and

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in response to determining that the second third co-user left a voicemail message for the user, displaying, within the window that includes the contacts list and in association with the identifier corresponding to the second co-user, a second graphical element, different from the first graphical element, configured to inform the user that the second co-user left a voicemail message for the user (*similar graphics are also readily applicable to indicate receptiveness to other communication media as well*) (p.15, para [0184]). One would have been motivated to do so in order to better monitor each other activity on the contacts the most frequently used communication media.

Claim 55: Doss Begole and Imamura disclose the computer-readable medium of claim 1 above, Imamura further discloses the first graphical element comprises an icon (fig. 6).

Claim 56: Doss Begole and Imamura disclose the computer-readable medium of claim 1 above, wherein the computer program further includes instructions that, when executed, cause a computer to:

Begole discloses determine that an email message has been exchanged between the user and a second one of the co-users (*comprising a list of contacts and associated awareness information, according to an embodiment of the present invention. This awareness information can be used to gauge the corresponding user's email receptiveness*) (p. 14, para. [0180]);

display, within the window that includes the contacts list and in association with the identifier corresponding to the second co-user (*an indication of email receptiveness is displayed within a graphical user interface of a computer system associated with the first email user, or sender*) p. 15, para [0194]); and Imamura discloses

determine a number of unread e-mail messages (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]);

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conditioned on the number of unread e-mail messages being greater than zero and a second graphical element that indicates that one or more unread e-mail messages (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]) [if there are no unread messages, there won't be anything to display].

Claim 57: Doss Begole and Imamura disclose the computer-readable medium of claim 56 above, Imamura further discloses the computer program further includes instructions that, when executed, cause a computer to:

enable the user to select the second graphical element; (*window 600 includes the names 605 of the registered users, where each name 605 may also serve as a user-selectable icon*) (p. 5, para. [0053]);

receive a selection of the second graphical element by the user (*window 600 includes the names 605 of the registered users, where each name 605 may also serve as a user-selectable icon*) [the icon is adjacent to each and is also selectable] (p. 5, para. [0053]) and

in response to the selection of the second graphical element by the user, display to the user the number of unread e-mail messages exchanged between the user and the second co-user (p. 5, para. [0053]).

Claim 60: Doss Begole and Imamura disclose the computer-readable medium of claim 1, Imamura further discloses the instructions for causing a computer to display to the user the number of unread e-mail messages exchanged between the user and the first co-user include instructions for causing the computer to display the number in a pop-up window or a dialog box that appears in response to selection of the first graphical element by the user (*window 600 includes the names 605 of the registered users, where each name 605 may also serve as a user-selectable icon*) [the icon is adjacent to each and is also selectable] (p. 5, para. [0053]).

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Claim 61: The claim incorporates substantially similar subject matter as claim 55, and is rejected along the same rationale.

Claim 62: The claim incorporates substantially similar subject matter as claim 56, and is rejected along the same rationale.

Claim 63: The claim incorporates substantially similar subject matter as claim 57, and is rejected along the same rationale.

Claim 64: The claim incorporates substantially similar subject matter as claim 60, and is rejected along the same rationale.

Claim 67: Doss discloses a computer- readable medium having embodied thereon a computer program, the computer program including instructions that, when executed, cause a computer to:

display, to a user of an instant messaging system, a graphical user interface that enables the user to access an instant messaging service, the graphical user interface comprising a window that includes a contacts list listing identifiers of other users, the identifiers of other users including a set of identifiers corresponding to co-users of the instant messaging service, the contacts list being configured to make online presence information for the co-users perceivable to the user and to enable the user to initiate communication sessions with the co-users (p.1, para [0007] and [0008]); but does not explicitly disclose;

determine a number of unread e-mail messages exchanged between the user and a first one of the co-users;

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display, within the interface that includes the contacts list and in association with the identifier in the list corresponding to the first co-user, a graphical element that displays the number of unread e-mail messages exchanged between the user and the first co-user.

However, Begole discloses

determine that an email message has been exchanged between the user and a first one of the co-users (*comprising a list of contacts and associated awareness information, according to an embodiment of the present invention. This awareness information can be used to gauge the corresponding user's email receptiveness*) (p. 14, para. [0180]);

display, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user (*an indication of email receptiveness is displayed within a graphical user interface of a computer system associated with the first email user, or sender*) p. 15, para [0194]);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the email exchange notification in Doss. One would have been motivated to do so in order to facilitate data sharing as required while the user is being notified of such data transferred.

However, Imamura discloses

determine a number of unread e-mail messages (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]);

a second graphical element that indicates that one or more unread e-mail messages (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]) [if there are no unread messages, there won't be anything to display]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the unread icon in Doss. One would have been motivated to do so in order to alert users about unread email.

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Claim 70: The claim incorporates substantially similar subject matter as claim 60, and is rejected along the same rationale.

Claim 71: Doss Begole and Imamura disclose the computer-readable medium of claim 70 above, Imamura further discloses the instructions for causing a computer to display the pop-up window or dialog box comprise instructions for causing the computer to display the pop-up window or dialog box in response to the user scrolling over the identifier corresponding to the first co-user in the window (p. 5, para. [0053]). One would have been motivated to do so in order to alert users about unread email.

Claim 72: Doss discloses a computer- readable medium having embodied thereon a computer program, the computer program including instructions that, when executed, cause a computer to:

display, to a user of an instant messaging system, a graphical user interface that enables the user to access an instant messaging service, the graphical user interface comprising a window that includes a contacts list listing identifiers corresponding to multiple co-users of the instant messaging service, the contacts list being configured to make online presence information for the co-users perceivable to the user and to enable the user to initiate communication sessions with the co-users (p.1, para [0007] and [0008]) but does not explicitly disclose;

determine whether unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access;

conditioned on determining that unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access, display within the window that includes the contacts list and in association with the identifier corresponding to the first co- user a graphical element that indicates to the user that unread e-mail messages are available for access; and

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conditioned on determining that no unread e-mail messages sent by the user to a first co- user or received by the user from the first co-user are available for access, not display within the window and in association with the identifier corresponding to the first co-user any graphical element related to e-mails or e-mail inbox content.

However, Begole discloses

determine that an email message has been exchanged between the user and a first one of the co-users (*comprising a list of contacts and associated awareness information, according to an embodiment of the present invention. This awareness information can be used to gauge the corresponding user's email receptiveness*) (p. 14, para. [0180]);

display, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user (*an indication of email receptiveness is displayed within a graphical user interface of a computer system associated with the first email user, or sender*) p. 15, para [0194]);

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the email exchange notification in Doss. One would have been motivated to do so in order to facilitate data sharing as required while the user is being notified of such data transferred.

However, Imamura discloses

determine whether unread e-mail messages are available for access (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]) [showing the number of messages implies that they are available for access];

conditioned on determining that unread e-mail messages sent or received and a graphical element that indicates to the user that unread e-mail messages are available for access (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]).

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conditioned on determining that no unread e-mail messages sent by the user to a first co- user or received by the user from the first co-user are available for access, not display within the window and in association with the identifier corresponding to the first co-user any graphical element related to e-mails or e-mail inbox content (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]) [if there are no unread messages, there won't be any display icons]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the unread icon in Doss. One would have been motivated to do so in order to alert users about unread email.

Claim 73: Doss Begole and Imamura disclose the computer-readable medium of claim 72 above, Imamura further discloses comprising instructions that, when executed, cause a computer to no longer display the graphical element within the window upon subsequently determining that the user accessed previously unread e-mail messages such that no unread e-mail messages from the first co-user remain presently available for access (p.5, para [0053]).

12. Claims 7-8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Begole et al. (US 2004/0039630 A1) in view of Imamura et al. (US 2002/0091774 A1) and in further view of Widger (US 2005/0117733).

Claim 7: Doss Begole and Imamura disclose the computer-readable medium of claim 1 above, wherein the computer program further includes instructions that, when executed, but do not explicitly disclose cause a computer to open or activate an application to read the unread email message when the first graphical element is again selected by the user. However, Widger discloses “a message notification portion when clicking on the icon accesses the associated application” (p. 5, par. [0038]). Therefore, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made to include that feature into Doss. One would have been motivated to add that feature in order to quickly access and review one's email content without interruption.

Claim 8: Doss Begole and Imamura disclose the computer-readable medium of claim 1 above, wherein the computer program further includes instructions that, when executed, cause a computer but do not explicitly disclose to open or activate an application listing multiple email messages exchanged between the user and the first co-user. However, Widger discloses "a message notification icon...with associated number of messages received" (p. 5, par. [0038]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a new message icon that shows listing of multiple e-mail messages in Doss. One would have been motivated to do so in order to better organize the email message inbox.

Claim 21: Doss Begole and Imamura disclose the method of claim 14 above, but do not explicitly disclose comprising displaying a list of one or more unread multiple email messages exchanged between the user and the first co-user in response to a second selection of the graphical element first indication by the user, the list of one or more unread multiple email messages being limited to email messages exchanged between the user and the first co-user. However, Widger discloses "a message notification icon...with associated number of messages received" (p. 5, par. [0038]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a new message icon that shows listing of multiple e-mail messages in Doss. One would have been motivated to do so in order to better organize the email message inbox.

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13. Claims 38, 43, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Begole et al. (US 2004/0039630 A1) in view of Imamura et al. (US 2002/0091774 A1) and in further view of Lee et al. (US 2003/0233265 A1).

Claim 38: Doss, Begole and Imamura disclose the method of claim 14 above. Imamura further discloses wherein displaying, within the window that includes the contacts list and in association with the identifier corresponding to the first co-user, a first graphical element that indicates that unread e-mail messages have been exchanged between the user and the first co-user includes displaying the first graphical element adjacent to the identifier in the contacts list that corresponds to the first co-user (p. 5, para. [0053]); but do not disclose

further comprising displaying, within the window that includes the contacts list and in association with the identifier corresponding to a second co-user, a second graphical element, different from the first graphical element, that indicates that a meeting has been scheduled that involves the user and the second co-user.

However, Lee discloses displaying, within the window that includes the contacts list and in association with the identifier corresponding to a second co-user, a second graphical element, different from the first graphical element, that indicates that a meeting has been scheduled that involves the user and the second co-user (p.3, para [0043],[0048] and fig. 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include scheduled meeting icon in Doss. One would have been motivated to do so in order to facilitate meeting schedule as required while the user is being notified of such meeting.

Claim 43: Doss, Begole and Imamura disclose the method of claim 14 above. Imamura further discloses displaying, within the window that includes the contacts list and concurrently with the first graphical

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element that indicates that a number of unread e-mail messages have been exchanged between the user and the first co-user (p. 5, para. [0053]) but do not explicitly disclose in association with the identifier corresponding to the second co-user, a second graphical element indication that indicates reflects that a meeting has been scheduled that involves the user and the second co-user includes displaying the second graphical element that indicates that a meeting has been scheduled that involves the user and the second co-user. However, Lee discloses in association with the identifier corresponding to the second co-user, a second indication that reflects that a meeting has been scheduled that involves the user and the second co-user include instructions that, when executed, cause a computer to display the second indication that reflects that a meeting has been scheduled that involves the user and the second co-user (p.3, para. [0043] and [0048]) [sending request to the invitees] One would have been motivated to do so in order to facilitate meeting schedule as required while the user is being notified of such meeting.

Claim 65: Doss Begole Imamura and Lee disclose the method of 38 above, Imamura further discloses the first graphical element comprises a first icon and the second graphical element comprises a second and different icon (fig. 6).

Claim 66: Doss Begole Imamura and Lee disclose the method of claim 43 above, Imamura further discloses the first graphical element comprises a first icon and the second graphical element comprises a second and different icon (fig. 6).

14. Claims 39-41, 58-59, 68-69, and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Begole et al. (US 2004/0039630 A1) in view of Imamura et al. (US 2002/0091774 A1) and in further view of Nielsen (US 6,108,688).

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Claim 39: Doss Begole and Imamura disclose the method of claim 14 above Imamura further discloses:

determining that a number of unread e-mail messages have an been exchanged between the user and a first one of the co-users includes determining that a number of e-mail messages were sent by the user to the first co-user (p. 5, para. [0053]) but does not explicitly disclose remain unread by the first co-user; and

displaying a first graphical element that indicates that one or more unread e-mail messages have been exchanged between the user and the first co-user (p. 5, para. [0053]) but does not explicitly disclose includes displaying a graphical element configured to inform the user that one or more e-mail messages were sent by the user to the first-co-user and remain unread by the first co-user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67)). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about outstanding email reply.

Claim 40: Doss Begole and Imamura disclose the method of claim 14 above Imamura further discloses:

determining that a number of unread e-mail messages have been exchanged between the user and a first one of the co-users includes determining that a number of e-mail messages were sent by the first co-user to the user and (p. 5, para. [0053]) but does not explicitly disclose remain unread by the user; and

displaying a first graphical element that indicates that one or more unread e-mail messages have been exchanged between the user and the first co-user (p. 5, para. [0053]) but does not explicitly disclose includes displaying a graphical element configured to inform the user that one or more e-mail messages

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were first sent by the first co-user to the user and remain unread by the user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about outstanding email reply.

Claim 41: Doss Begole and Imamura disclose the method of claim 14 above Imamura further discloses:

determining that a number of unread e-mail messages have been exchanged between the user and a first one of the co-users includes determining that a number of e-mail messages were sent by the user to the first co-user (p. 5, para. [0053]) but does not explicitly disclose remain unread by the first co-user; and

displaying a first graphical element that indicates that one or more unread e-mail messages have been exchanged between the user and the first co-user (p. 5, para. [0053]) but does not explicitly disclose includes displaying a graphical element configured to inform the user that one or more e-mail messages were sent by the user to the first-co-user and remain unread by the first co-user; and

the method further comprises:

determining that a third one of the co-users has sent a number of e-mail message to the user (p. 5, para. [0053]) but does not explicitly disclose remain unread by the user; and

conditioned on the number of unread e-mail messages sent by the third co-user to the user being greater than zero, displaying, within the window that includes the contacts list and in association with the identifier corresponding to the third co-user, a second graphical element configured to inform the user that the third co-user has sent one or more e-mail messages to the user (p. 5, para. [0053]) but does not

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explicitly disclose remain unread by the user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about outstanding email reply.

Claim 58: Doss Begole and Imamura disclose the computer-readable medium of claim 1 above, Imamura further discloses:

the instructions for causing a computer to determine that a number of unread e-mail messages have been exchanged between the user and a first one of the co-users includes instructions for causing a computer to determine that a number of e-mail messages were sent by the user to the first co-user (p.5, para. [0053]) but do not explicitly disclose remain unread by the first co-user ; and

the instructions for causing a computer to display a first graphical element that indicates that one or more unread e-mail messages have been exchanged between the user and the first co-user includes instructions for causing a computer to (p.5, para. [0053]) but do not explicitly disclose display a graphical element configured to inform the user that one or more e-mail messages were sent by the user to the first co-user and remain unread by the first co-user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67). Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to include sender notification in Doss.

One would have been motivated to do so in order to remind the sender about outstanding email reply.

Claim 59: Doss Begole and Imamura disclose the computer-readable medium of claim 1 above, Imamura further discloses:

the instructions for causing a computer to determine that a number of unread e-mail messages have been exchanged between the user and a first one of the co-users includes instructions for causing a computer to determine that a number of e-mail messages were sent by the first co-user to the user (p.5, para. [0053]) but do not explicitly disclose remain unread by the user; and

the instructions for causing a computer to display a first graphical element that indicates that one or more unread e-mail messages have been exchanged between the user and the first co- user includes instructions for causing a computer to (p.5, para. [0053]) but do not explicitly disclose display a graphical element configured to inform the user that one or more e-mail messages were sent by the first co-user to the user and remain unread by the user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about outstanding email reply.

Claim 68: The claim incorporates substantially similar subject matter as claim 58, and is rejected along the same rationale.

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Claim 69: The claim incorporates substantially similar subject matter as claim 59, and is rejected along the same rationale.

Claim 74: Doss Begole and Imamura disclose the computer-readable medium of claim 72 above, Imamura further discloses:

the instructions that cause a computer to determine whether unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access comprise instructions that cause a computer to determine whether unread e-mail messages sent by the user to the first co-user are available for access by the first co-user (p.5, para [0053]); and

the instructions that cause a computer to display within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages are available for access comprise instructions that cause a computer to, conditioned on determining that unread e-mail messages sent by the user to the first co-user are available for access by the first co-user, display within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element configured (p.5, para [0053]) to but do not explicitly disclose inform the user that e-mail messages sent by the user to the first co-user have not been read by the first co-user and remain not read by the first co-user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about outstanding email reply.

Claim 75: Doss Begole and Imamura disclose the computer-readable medium of claim 72 above, Imamura further discloses:

the instructions that cause a computer to determine whether unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access comprise instructions that cause a computer to determine whether unread e-mail messages received by the user from the first co-user are available for access by the user (p.5, para [0053]); and

the instructions that cause a computer to display within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages are available for access comprise instructions that cause a computer, conditioned on determining that unread e-mail messages received by the user from the first co-user are available for access by the user, display within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element configured (p.5, para [0053]) to but do not explicitly disclose to inform the user that e-mail messages sent by the first co-user to the user have not been read by the user and remain not read by the user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about outstanding email reply.

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15. Claim 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Nielsen (US 6,108,688) and in further view of Imamura et al. (US 2002/0091774 A1).

Claim 76: Doss discloses a method comprising:

displaying, to a user of an instant messaging system, a graphical user interface that enables the user to access an instant messaging service, the graphical user interface comprising a window that includes a contacts list listing identifiers corresponding to multiple co-users of the instant messaging service, the contacts list being configured to make online presence information for the co-users perceivable to the user and to enable the user to initiate communication sessions with the co-users (p.1, para [0007] and [0008]) but does not explicitly disclose;

receiving an e-mail message addressed to the user from a first co-user, the user having no unread e-mail messages received from the first co-user prior to receipt of the e-mail message; and

in response to the e-mail message, displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages received by the user from the first co-user are available for access by the user, wherein no graphical element related to e-mails or e-mail inbox content was displayed in the window in association with the identifier corresponding to the first user prior to receipt of the e-mail message.

However, Nielsen discloses as shown by decision 210, the program checks whether the message has been seen previously, or whether it is a new message that has not been seen previously. (col. 8, lines 42-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about new email.

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However, Imamura discloses (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]) [if there are no unread messages, there won't be any display icons]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the unread icon in Doss. One would have been motivated to do so in order to alert users about unread email.

16. Claims 77-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Imamura et al. (US 2002/0091774 A1).

Claim 77: Doss discloses a method comprising:

displaying, to a user of an instant messaging system, a graphical user interface that enables the user to access an instant messaging service, the graphical user interface comprising a window that includes a contacts list listing identifiers corresponding to multiple co-users of the instant messaging service, the contacts list being configured to make online presence information for the co-users perceivable to the user and to enable the user to initiate communication sessions with the co-users (p.1, para [0007] and [0008]) but does not explicitly disclose

determining that unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access;

displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages are available for access;

enabling the user to select the graphical element;

receiving a selection by the user of the graphical element; and

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in response to the selection by the user of the graphical element, presenting to the user a subset of the user's unread e-mail messages that includes the unread e-mail messages sent by the user to the first co-user or received by the user from the first co-user.

However, Imamura discloses

determining that unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]);

displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages are available for access (*associated with each registered user's name is a numeral that represents the number of unread messages addressed to the respective user*) (p. 5, para. [0053]) [if there are no unread messages, there won't be anything to display].

enable the user to select the first graphical element (*window 600 includes the names 605 of the registered users, where each name 605 may also serve as a user-selectable icon*) (p. 5, para. [0053]);

receive a selection of the first graphical element by the user (*window 600 includes the names 605 of the registered users, where each name 605 may also serve as a user-selectable icon*) [the icon is adjacent to each and is also selectable] (p. 5, para. [0053]); and

in response to the selection by the user of the graphical element, presenting to the user a subset of the user's unread e-mail messages that includes the unread e-mail messages sent by the user to the first co-user or received by the user from the first co-user (p. 5, para. [0053], [0056]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the unread icon in Doss. One would have been motivated to do so in order to alert users about unread email.

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Claim 78: Doss and Imamura discloses the method of claim 77 above, Imamura further discloses presenting to the user the subset of the user's unread e-mail messages comprises opening or activating an e-mail application and displaying to the user the subset of the user's unread e-mail messages in an e-mail application user interface in response to and upon receiving the selection by the user of the graphical element (p. 5, para. [0053],[0056])

Claim 79: Doss and Imamura discloses the method of claim 77 above, Imamura further discloses presenting to the user the subset of the user's unread e-mail messages comprises presenting to the user a subset that consists only of e-mail messages sent by the user to the first co-user or received by the user from the first co-user (p. 5, para. [0053],[0057]).

17. Claims 80-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss (US 2003/0046296 A1) in view of Imamura et al.(US 2002/0091774 A1) and in further view of Nielsen (US 6,108,688)

Claim 80: Doss and Imamura discloses the method of claim 77, Imamura further discloses:

determining whether unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access comprises determining whether unread e-mail messages sent by the user to the first co-user are available for access by the first co-user (p. 5, para. [0053]);

presenting to the user the subset comprises presenting to the user, in response to the selection by the user of the graphical element, a subset of the user's unread e-mail messages that includes the unread e-mail messages sent by the user to the first co-user (p. 5, para. [0056]).

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displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail messages are available for access comprises displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element configured (p. 5, para. [0053]) but do not explicitly disclose to inform the user that e-mail messages sent by the user to the first co-user have not been read by the first co-user and remain not read by the first co-user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about outstanding email reply.

Claim 81: Doss and Imamura discloses the method of claim 77, Imamura further discloses:

determining whether unread e-mail messages sent by the user to a first co-user or received by the user from the first co-user are available for access comprises determining whether unread e-mail messages received by the user from the first co-user are available for access by the user (p. 5, para. [0053]);

presenting to the user the subset comprises presenting to the user, in response to the selection by the user of the graphical element, a subset of the user's unread e-mail messages that includes the unread e-mail messages received by the user from the first co-user (p. 5, para. [0056]);

displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element that indicates to the user that unread e-mail

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messages are available for access comprises displaying within the window that includes the contacts list and in association with the identifier corresponding to the first co-user a graphical element configured (p. 5, para. [0053]) but do not explicitly disclose to inform the user that e-mail messages sent by the first co-user to the user have not been read by the user and remain not read by the user. However, Nielsen discloses providing the sender of an e-mail message with the capability of automatically generating a warning message on the sender's system if the recipient of the message has not opened the message by a time specified by the sender and the sender's e-mail program is modified to include the capability of providing a warning in case the sender's e-mail message is not opened by the recipient. (col. 1, lines 54-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include sender notification in Doss. One would have been motivated to do so in order to remind the sender about outstanding email reply.

Response to Arguments

18. Applicant's arguments filed on 7/17/2008 have been fully considered but they are not persuasive but rather moot in view of the new ground(s) of rejection.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Daniell et al. (US 2004/0054735A1) discloses multi-system instant messaging (IM).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phenuel S. Salomon whose telephone number is (571) 270-1699. The examiner can normally be reached on Mon-Fri 7:00 A.M. to 4:00 P.M.(Alternate Friday Off) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272 4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSS
9/15/2008

/Joshua D Campbell/
Primary Examiner, Art Unit 2178